

BRIEF IN SUPPORT OF PETITION.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is unreported (R. 209). The opinion of the Circuit Court of Appeals is reported, 153 Fed. (2d) 905, (R. 310).

JURISDICTION.

This is a suit arising under the patent laws of the United States, JUDICIAL CODE, Sec. 24(7) (28 U.S.C. 41 (7)). The date of the judgment is February 28, 1946 (R. 314). The statute under which jurisdiction is invoked is Section 240(a) of the JUDICIAL CODE (28 U.S.C. 347, as amended). Cases believed to sustain the jurisdiction are *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 546; *Schriber Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 487; *Morton Salt Co. v. Suppiger Co.*, 314 U.S. 488, 490.

STATEMENT.

The facts, so far as this application is concerned, are stated in the petition.

SPECIFICATION OF ERRORS.

The errors which Petitioner will urge, if the writ of certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding claims 6, 7 and 8 of patent 2,069,395 valid.

2. In failing to hold that said claims are invalid because of anticipation and also want of invention.

3. In reading into the claims limitations not included therein and which the patentee expressly stated should not be read into them.

4. In not following the decisions of this Court on the questions of anticipation, invention, and claim interpretation.

5. In ascribing functions and results to the combination of the claims entirely foreign to the combination of elements recited in the claims.

SUMMARY OF ARGUMENT.

The summary of argument is set forth in the petition under reasons 1, 2 and 3 relied upon for the allowance of the writ, and, for the sake of brevity, are not repeated at this point.

ARGUMENT.

I. It is the claims of a patent which define and measure the invention and the claims here being fully and squarely anticipated by the prior Jones and Lindsay viewing devices cannot be saved by reading into them parts of the specifications which the patentee not only failed to include in them but expressly stated were not to be included. In *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp. et al.*, 294 U.S. 477, this Court stated at page 487:

> "The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel,

> the flexible connection of the flywheel and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention. See *White v. Dunbar,* 119 U.S. 47, 51, 52; *McClain v. Ortmayer,* 141 U.S. 419, 423-425; *The Paper Bag Patent Case,* 210 U.S. 405, 419; *Smith v. Snow, ante,* p. 11. And each claim must stand or fall, as itself sufficiently defining invention, independently of the others. See *Carlton v. Bokee,* 17 Wall. 463, 472; *Russell v. Place,* 94 U.S. 606, 609; *Leeds & Catlin Co. v. Victor Talking Machine Co.,* 213 U.S. 301, 319; *Symington Co. v. National Malleable Castings Co.,* 250 U.S. 383, 385; *Smith v. Snow, supra;* Walker on Patents, Sec. 220, 6th Ed. As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

And in *McCarty v. Lehigh Valley R. R. Co.,* 160 U.S. 110, 116, this Court stated:

> "We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement."

To the same effect are the decisions of this Court in the other cases cited in the petition under the first of the reasons relied upon for the allowance of the writ.

In *Milcor Steel Co. v. George A. Fuller Co.,* 316 U.S. 143, there was an attempt to revise by disclaimer the claims of the patent there in suit by adding an element from the specification but not included in the claims as granted. This Court condemned such procedure stating (316 U.S. 145-6):

"As the courts below pointed out, it is these claims, not the specifications, that afford the measure of the grant to the patentee. 'Out of all the possible permutations of elements which can be made from the specifications, he reserves for himself only those contained in the claims.' 122 F. 2d 292, 294. The foregoing features appearing in the specifications are not set out in the claims themselves; the claims do not indicate in any way that these features were essential parts of the combination for which the patent was issued. On the contrary, Holdsworth asserted that his specifications in general showed only a 'preferred embodiment' of his invention, and with respect to the ceiling member in particular, stated: 'I do not wish to be limited to an angle iron for completing the top of the metal construction.'

"The disclaimers, however, purported to make these two features essential parts of the claimed combination. * * * Limiting ourselves, as we must, to the original claims to determine the nature of the combination covered by the patent when it was granted, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent includes new elements which were not present in the original."

If such claim revision is invalid under disclaimer procedure, it follows, we think, that any such revision by judicial interpretation must likewise be invalid.

Petitioner is not unmindful of and has no quarrel with the rule and authorities to the effect that the specification and drawings of a patent may be referred to as an aid in construing what is set forth in the claims. The courts below have gone far beyond that in this case. *Here recourse has been had to the specification not for the purpose of construing what is set forth in the claims but for*

the purpose of revising the claims to include elements not present therein.

The Jones and Lindsay patents do not specifically mention the application of their viewing devices to grinding machines, but no such combination is set forth in the claims in suit. The invention defined in the claims is a viewing device *per se* susceptible of many different uses and applications and is so described in the specification, (R. 240, 2nd col. ls. 52-54) and the Jones and Lindsay devices are likewise viewing devices and are likewise susceptible of many different uses and applications and are so described.[6] The lack of specific mention in the Jones and Lindsay patents of use of their viewing devices as shields on grinding machines in no way impairs their anticipatory significance, for under long established authority of this Court it is not invention to use an old device for a new and analogous purpose. (*Roberts v. Ryer*, 91 U.S. 150, 157; *Phillips v. Page*, 24 How. 164, 167; *Pennsylvania Railroad Company v. Locomotive Truck Co.*, 110 U.S. 490, 494-496; *Ansonia Co. v. Electrical Supply Co.*, 144 U.S. 11, 18; *Potts v. Creager*, 155 U.S. 597, 608; *Dow v. Halliburton*, 65 S. Ct. 647, 650; 324 U.S. 320; *Cuno Engineering Corporation v. Automatic Devices Corp.*, 314 U.S. 84, 91). The prior art in the instant case teaches and contains many examples of the use of viewing devices as shields on grinding machines (R. 139, 147, 163, 165, 167, 169, 171, 173, 175, 177, 179, 252, 258, 270, 276, 280).

Furthermore, the introductory phrase "a safety shield" of the claims in suit merely states the intended purpose

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[6] See specification of Lindsay patent R. 297, ls. 8-10, "use by mechanics, watch makers, and artisans of various kinds where fine work is involved," and R. 298, ls. 128-131, "the foregoing will so fully reveal the gist of this invention that others can by applying current knowledge readily adapt it for various applications."

or use of the device and imports nothing in the way of structural elements into the claims. (*Ford Motor Co. v. Parks & Bohne*, C.C.A. 6th, 21 Fed. (2d) 943, 946, citing *McCarty v. Lehigh Valley R. R. Co.*, 160 U.S. 110, 116, and then Circuit Judge Taft in *Stearns v. Russell*, C.C.A. 6th, 85 Fed. 218, 224, certiorari denied 171 U.S. 689; *Grosjean et al v. Panther-Panco Rubber Co., Inc.*, C.C.A. 1st, 113 Fed. (2d) 252, 256; *Hookless Fastener Co. v. G. E. Prentice Mfg. Co.*, C.C.A. 2nd, 68 Fed. (2d) 940, 941; *Walker on Patents, Deller's Ed.*, Vol. II, Sec. 274, Page 1271.)

II. Assuming that failure of Jones and Lindsay to make specific reference to use of their viewing devices on grinding machines deprives those devices of technical responsiveness to the introductory term "safety shield" used in the claims in suit, the claims are nevertheless invalid for want of invention.

The gist of the alleged invention was the use in the old grinding wheel safety shields (R. 135, 163-179, incl., 276) of two lamps instead of one to provide shadowless illumination also old in the prior art (R. 183, 185, 187, 189, 248, 288, 296). The Court of Appeals stated (R. 312):

> "Each of these disclosures (single lamp safety shields) of prior art has but a single light, and for that reason neither affords shadowless illumination of the wheel and work when viewed through the shield."

To incorporate the second lamp in these old single lamp safety shields to afford shadowless illumination was utterly devoid of invention in view of the prior use in the Jones and Lindsay devices of two or more lamps for precisely that very same purpose.

The Lindsay patent contains a clear and unequivocal disclosure and description of shadowless illumination in

a viewing device (R. 297, ls. 38-42; 58-62; R. 298, ls. 27-31, 106-114), and shadowless illumination was common everyday practice in almost every conceivable industry and art, as for example shaving mirrors, dressing tables, show windows, display cases, stage lighting, surgery, compasses (R. 248), machine tools (R. 183-189. incl.) etc. No new result or function was therefore evolved from the addition of the second lamp to provide shadowless illumination in the old and well-known single lamp safety shields.

As was stated by this Court in *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, after reviewing the earlier decisions of this Court (pages 433, 434):

> "Applying the rule thus authoritatively settled by this Court, we think no invention is shown in assembling these old elements for the purposes declared. *No new function is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements.*
>
> "In the gearing specified every element is old. The operations of the wringer and the washing machine, although simultaneous, are independent one of the other. The control of the operation of the wringer is by an old and well-known method. *From the co-operation of the elements, here brought together no new result, involving the exercise of the creative faculty which is invention, is achieved.*"

Applying this test to the elements of the claims in suit, it cannot fairly be denied that the shield merely performs the old and well-known function of a shield and the two lamps, the old and well-known function of shadowless illumination. The operations of these elements, although simultaneous, are independent one of the other. The only result achieved is that which "arises

from the well-known operations of each one of the elements", and "no new function is 'evolved from this combination.'"

As this Court also said in *Powers-Kennedy Contracting Corporation, et al. v. Concrete Mixing and Conveying Co.*, 282 U.S. 175, 186:

> "For these reasons we find that the patent is invalid. It consists of a combination of elements all of which were old in the art. Its application to the transportation of concrete did not involve invention. Neither the combination of old elements or devices accomplishing no more than an aggregate of old results (*Hailes v. Van Wormer*, 20 Wall. 353; *Office Specialty Mfg. Co. v. Fenton Metallic Mfg. Co.*, 174 U.S. 492; *Grinnell Washing Machine Co. v. E. E. Johnson Co.*, 247 U.S. 426) nor the use of an old apparatus or appliance for a new purpose (*Roberts v. Ryer*, 91 U.S. 150), is invention."

Also, as said by this Court in *Electric Cable Joint Co. v. Brooklyn Edison*, 292 U.S. 69, 79, the addition made by the patentee—

> "must be the result of invention, not the mere exercise of the skill of the calling and *not one plainly indicated by the prior art.*"

III. As a prerequisite to the grant of a patent, Congress has required that the patentee "distinctly claim the part, improvement or combination which he claims as his invention," (Sec. 4888, R.S.; U.S.C. Title 35, Sec. 33). As we have shown, the claims here in suit drawn in compliance with this statutory requirement read squarely upon and are anticipated by the prior art. To hold such claims valid by rewriting, revising or interpreting them to include elements not recited by them is to overlook the public interest, for the public has the right to rely upon the claims as granted, and if as granted they

encroach upon the public domain they are invalid and unenforceable.

In *White v. Dunbar,* 119 U.S. 47, 52, this Court stated:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See *Keystone Bridge Co. v. Phoenix Iron Co.,* 95 U.S. 274, 278; *James v. Campbell,* 104 U.S. 356, 370."

And in *Mercoid Corp. v. Mid-Continent Investment Co.,* 320 U.S. 661, 665, this Court stated:

> "It is the public interest which is dominant in the patent system."

The decisions of the courts below are in conflict with the applicable decisions of this Court and should be overruled.

Respectfully submitted,

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